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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,332	05/15/2001	Grigoriy S. Tchaga	CLON-056CIP	2176
24353	7590	01/12/2006	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP			SWOPE, SHERIDAN	
1900 UNIVERSITY AVENUE			ART UNIT	
SUITE 200			PAPER NUMBER	
EAST PALO ALTO, CA 94303			1656	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/858,332	<b>Applicant(s)</b> TCHAGA ET AL.	
	<b>Examiner</b> Sheridan L. Swope	<b>Art Unit</b> 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-20, 26-28 and 30-47 is/are pending in the application.
- 4a) Of the above claim(s) 30-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15, 16, 39, and 40 is/are allowed.
- 6) ☒ Claim(s) 17, 18, 26, 41, 42 and 45 is/are rejected.
- 7) ☒ Claim(s) 19, 20, 27, 28, 43, 44, 46 and 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicant's election, with traverse, of Invention I, drawn to a polynucleotide encoding a metal ion affinity peptide, Claims 15-20, 26-28, and 39-47, in their response of October 25, 2005, is acknowledged.

Applicants' traversal is based on the argument that it would not be unduly burdensome to search all claims. Said argument is not found to be persuasive. The reasons searching all claims would be a burden on the Office was explained in the Restriction/Election requirement. In brief, because the products of Inventions I and II are physically and functionally distinct chemical entities, a search for more than one of Inventions I and II would be a burden on the Office.

Claims 15-20, 26-28, and 30-47 are pending. Claims 30-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Claims 15-20, 26-28, and 39-47 are hereby examined.

### ***Priority***

The priority date granted for the instant invention, a polynucleotide encoding a metal ion affinity peptide having the formula  $\text{NH}_2\text{-(His-Asn)}_n$  or  $\text{(His-Asn)}_n\text{-COOH}$ , where  $n=6$  is September 25, 1998, the filing date of provisional application US60/101,867. The priority date granted for the instant invention, a polynucleotide encoding a metal ion affinity peptide having the formula  $\text{NH}_2\text{-(His-Asn)}_n$  or  $\text{(His-Asn)}_n\text{-COOH}$ , where  $n=3, 4, 5, 7, 8, 9, \text{ or } 10$  is May 15, 2001, 2001, the filing date of the instant non-provisional application, US09/858,332.

### ***Oath-Objections***

The Oath is objected to because the change of address for Grigoriy Tchga in the Oath/Declaration received August 13, 2001 is not initialed or dated. See M.P.E.P. 605.04(a),

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which states that, any changes made to the Oath/Declaration should be initialed and dated by the Applicants prior to execution. The Office will not consider whether non-initialed and/or non-dated alterations were made before or after signing of the Oath or Declaration but will require a new Oath or Declaration (37 CFR 1.64).

The Oath is also objected to because the address for George Jokhadze is not provided.

### ***Drawings***

Figure 2 is objected to because the polynucleotide sequence disclosed therein, residues 1-3425 is not identified by a sequence identifier number (SEQ ID NO: ). Figure 2 is also objected to because the polypeptide sequence encoded by residues 2218-3025 of the polynucleotide disclosed therein is not identified by a sequence identifier number (SEQ ID NO: ).

Figure 3 is objected to because the sequence disclosed therein is not identified by a sequence identifier number (SEQ ID NO: ).

### ***Specification-Objections***

The specification is objected to for failing to state, in the first sentence, that the parent application, US09/404,017, is abandoned.

The legend to Figure 2, filed July 11, 2005, is objected to because the phrase “nucleotides 3028-3058 is SEQ ID NO: 26”, on line 4, should be “nucleotides 3028-3058 is SEQ ID NO: 27” and the term “lower” on line 5 should be “lower”.

### ***Title***

The title is objected to because it is not descriptive of the elected invention.

### ***Sequence Listing***

The sequence listing is objected to for the following reasons.

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The sequences for SEQ ID NO: 6 and SEQ ID NO: 24 are identical. Deletion of SEQ ID NO: 6 or 24 is required. Appropriate changes should be made in the specification and/or drawings to reflect any changes made to the sequence listing.

The names for SEQ ID NO: 7-10, as disclosed in line <223>, are incorrect. SEQ ID NO: 7 is factor Xa, SEQ ID NO: 8 is thrombin, SEQ ID NO: 9 is rennin, and SEQ ID NO: 10 is an immunological tag. Corrections are required.

***Claim Rejections - 35 USC § 112-Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 18, 26, 41, 42, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For Claim 17, the phrase “a polynucleotide according to claim 15” renders the claim indefinite. It is unclear whether the claim is meant to recite “the” polynucleotide according to claim 15 or “any” polynucleotide according to claim 15. The latter would encompass nucleotides as small as two residues. Clarification is required. For purposes of examination, it is assumed that Claim 17 is meant to recite the polynucleotide according to claim 15.

For Claim 18, the phrase “a recombinant vector according to claim 17” renders the claim indefinite. It is unclear whether the claim is meant to recite “the” recombinant vector according to claim 17 or “any” recombinant vector according to claim 17. The latter would encompass vectors comprising nucleotide fragments of the sequence of claim 15, which may be as small as

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two residues. Clarification is required. For purposes of examination, it is assumed that Claim 18 is meant to recite the recombinant vector according to claim 17.

For Claim 26, the phrase “a recombinant vector according to claim 17” renders the claim indefinite. It is unclear whether the claim is meant to recite “the” recombinant vector according to claim 17 or “any” recombinant vector according to claim 17. The latter would encompass vectors comprising nucleotide fragments of the sequence of claim 15, which may be as small as two residues. Clarification is required. For purposes of examination, it is assumed that Claim 26 is meant to recite the recombinant vector according to claim 17.

For Claim 41, the phrase “a polynucleotide according to claim 39” renders the claim indefinite. It is unclear whether the claim is meant to recite “the” polynucleotide according to claim 15 or “any” polynucleotide according to claim 39. The latter would encompass nucleotides as small as two residues. Clarification is required. For purposes of examination, it is assumed that Claim 41 is meant to recite the polynucleotide according to claim 39.

For Claim 42, the phrase “a recombinant vector according to claim 41” renders the claim indefinite. It is unclear whether the claim is meant to recite “the” recombinant vector according to claim 41 or “any” recombinant vector according to claim 41. The latter would encompass vectors comprising nucleotide fragments of the sequence of claim 39, which may be as small as two residues. Clarification is required. For purposes of examination, it is assumed that Claim 42 is meant to recite the recombinant vector according to claim 41.

For Claim 45, the phrase “a recombinant vector according to claim 41” renders the claim indefinite. It is unclear whether the claim is meant to recite “the” recombinant vector according to claim 41 or “any” recombinant vector according to claim 41. The latter would encompass

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vectors comprising nucleotides fragments of the sequence of claim 39, which may be as small as two residues. Clarification is required. For purposes of examination, it is assumed that Claim 45 is meant to recite the recombinant vector according to claim 41.

***Allowable Subject Matter***

Claims 15, 16, 39, and 40 are allowable.

Claims 19, 20, 27, 28, 43, 44, 46, and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943.

The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Lee Swope, Ph.D.  
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**SHERIDAN SWOPE, Ph.D.**  
**PATENT EXAMINER**